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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,265	03/31/2006	Mitsuteru Mutsuda	2224-0255PUS1	9018

2292 7590 06/24/2010
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EXAMINER

FREEMAN, JOHN D

ART UNIT	PAPER NUMBER
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1787

NOTIFICATION DATE	DELIVERY MODE
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06/24/2010

ELECTRONIC

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ADVISORY ACTION

The proposed amendment will not be entered because it contains new limitations that require further consideration and search. Specifically, in proposed claim 1 Applicant limits the number average molecular weight of the polyamide oligomer to values not previously required.

Applicant states there is no motivation to combine Matsumoto with Oenbrink and Goetz (p9). The examiner respectfully disagrees. As noted in paragraph 10 of the Final Rejection mailed 9 March 2010:

At the time of the invention, it would have been obvious to one of ordinary skill in the art to use Oenbrink's polyamide containing a polyamine to ensure good adhesion to polyurethane elastomer substrate taught by Matsumoto.

Also note paragraph 31 of the same Final Rejection:

At the time of the invention, it would have been obvious to one of ordinary skill in the art to use Goetz's teaching of a blend of polyester and polyamide oligomer with Oenbrink's teaching of a polyamine-containing polyamide to arrive at a covering for Matsumoto's polyurethane substrate, wherein the covering would have improved flowability and adhesion to the substrate.

The examiner maintains these motivations to combine the references.

Applicant states the problems solved by Matsumoto "are not in common" with Oenbrink and Goetz, but Applicant fails to elaborate the differences (p9). The examiner notes the references all relate to the same field of endeavor: polymers and composites.

Applicant states the examiner's rejections are based on hindsight reasoning. In response to Applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The examiner maintains the reasons for combining the references as explained would be apparent to one of ordinary skill in the art.

Applicant states "the graft copolymer [of Oenbrink] has not yet contained the free polyamine" and argues the polyamine is "only a co-monomer" (p9). The examiner notes examined claim 1 requires only "a thermoplastic resin (Ib) compris[ing]...an amino group-containing compound." Oenbrink's copolymer contains an amino group-containing compound, i.e., polyamine, and therefore meets the requirements of the claim.

Applicant states Goetz's polyamide oligomer is condensated after mixing with the thermoplastic polyester elastomer (p9). The examiner notes examined claim 13 requires only a "resin composition" of a polyamide oligomer and a polyester resin. The uncured, non-condensed form of Goetz's resin would meet the limitations of the present claims.

Applicant states "Oenbrink does not teach the significance of a combination of alicyclic monomers with specific concentration of an amino group" (p9). Note the features upon which Applicant relies (i.e., alicyclic monomers with specific concentrations of an amino group) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The examined claim 3 requires only that the "non-urethane thermoplastic resin (Ib) has an amino group in a concentration of not less than 10 mm/kg." There is no requirement that the alicyclic monomer contains the amino group in a specific concentration.

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Applicant states there are unexpected advantages to the present invention, in particular the bond strength between the non-urethane resin and a thermoplastic polyurethane resin member (p10). Applicant also points to the Examples in the specification as evidence. The examiner does not find these arguments persuasive, however, for the following reasons:

- 1) Oenbrink teaches polyamide graft copolymers falling under the scope of the present claims, and further teaches they are suitable as adhesives.
- 2) The data, i.e., the Examples, are not persuasive because they are not commensurate in scope with the present claims. The Examples disclose specific polymers having specific concentrations while the present claim 1 requires only a non-urethane thermoplastic resin comprising a polyamide having an alicyclic ring, or an amino-group containing compound.
- 3) The data are not persuasive also because Example 6, which appears to be a comparative example though not identified as such, having an amino group concentration of 4 mmol/kg—less than the claimed minimum of 10 mmol/kg—adheres more strongly to polyether polyurethane compared to Example 4 and adheres nearly the same amount as Example 5 (see Table 1). Therefore, the results seem dependent on the identity of the polyurethane resin member, contradicting Applicant's statements.

If it were entered, Applicant's amendments would overcome previous rejections under 35 USC 112.

/John Freeman/
Examiner, Art Unit 1787

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1787